REMARKS

In the April 22, 2004 Office Action, the Examiner noted that claims 16-29 were pending, rejected claims 16-29 under the first paragraph of 35 U.S.C. § 112; rejected claim 16 under the second paragraph of 35 U.S.C. § 112; and rejected claims 16-29 under 35 U.S.C. § 103. In rejecting the claims, U.S. Patents 6,115,496 to Nguyen et al. and 4,803,477 to Miyatake et al. were cited. Claims 16-29 remain in the case. The Examiner's rejections are traversed below.

Rejection of Claims 16-29 under 35 U.S.C. § 112, First Paragraph

In paragraphs 7-8 on page 3 of the Office Action, claims 16-29 were rejected under the first paragraph of 35 U.S.C. § 112 for lack of enablement. However, most of paragraphs 7 and 8 describe statements in the specification (including Fig. 1) that the Examiner did not understand. The only claim language that is cited as not enabled is "determining an index by reference ..." (claim 16, starting at line 6). As a result, it is unclear exactly what operations recited in the claims the Examiner believes one of ordinary skill in the art would be unable to cause a computer to perform without undue experimentation. The language that Examiner is apparently referencing will be discussed below. However, as noted in the February 3, 2004 Amendment, it is believed that these issues could be addressed much more efficiently in an Examiner Interview and a request for same is repeated below.

With respect to the operation of "determining an index by reference to the at least one parameter" (claim 16, line 6), as noted by the Examiner the specification states that "[d]uring the determining of an index, a value (index) is uniquely determined from the first object" (Substitute Specification, page 5, lines 4-5 of paragraph 27). However, there are numerous other portions of the specification that mention determining an index. The language in the claims, "determining an index by reference to the at least one parameter" is used in the specification on line 3 of paragraph 6 and similar statements appear in paragraphs 8, 22 and 23. In paragraph 8 it is stated that "[p]referably the index is determined as a uniquely defined index" and in paragraph 27, right after the language quoted at the end of paragraph 8 on page 3 of the Office Action, details of how the index is determined are provided in the statements that

> an identification variable 108 is preferably determined from the first object. This variable is also taken into account in determining the index. The identification variable 108 permits uniquely defined assignment or virtually uniquely defined assignment of the first object 101 to the identification variable 108. Various methods of doing this are known, for example an assignment by an Internet link (URL address)

(Substitute Specification, paragraph 27, lines 6-10, as amended above to further improve the translation). As stated in paragraph 27, how to determine an index is known and a common example is an Internet link. If the Examiner has any questions regarding this operation recited in the claims, it is strongly suggested that the Examiner contact the undersign to arrange an Examiner Interview, as requested in the February 3, 2004 Office Action.

As noted above, paragraphs 7 and 8 on page 3 of the Office Action contain statements regarding other language in the specification that was not understood by the Examiner, without identifying limitations in the claims that therefore were not enabled. The first such language is "conversion with the parameters p1, p2, p3" (paragraph 27, line 2) regarding which the Examiner asked, "**what is conversion and what are these parameters**" (Office Action, page 3, line 6, emphasis in original). Both claim 16 and the specification provide a context for the phrase "conversion with the parameters p1, p2, p3" in paragraph 27. Claim 27 recites that the object is "a mapping object" (claim 16, line 1) that is retrieved "when a digital image is modified by a predefined process" (claim 16, lines 3-4). An example used in the specification for the process is "[c]ompression" (paragraph 27, line 3) which also appears in block 105 of Fig. 1. It is unclear why the Examiner does not understand that compression is a form of conversion of an image. Once again, it is submitted that clarification of these questions could have been addressed much more efficiently in an Examiner Interview. It is not understood why the Examiner did not contact the undersigned prior to issuing the April 22, 2004 Office Action, if the Examiner had such questions.

With respect to the "parameters p1, p2, p3", it is submitted that one of ordinary skill in the art of manipulating digital images was well aware that there are parameters that can be extracted from a mapping object, so that a digital image can be compressed or manipulated in another manner. Numerous examples of techniques for compressing digital images could be cited. The Examiner is respectfully requested to inform the undersigned at an Examiner Interview how many examples are needed if these remarks are not sufficient to overcome the rejection.

Although compression is used as an example in the specification and is discussed in the preceding paragraphs, claim 16 is not limited to a process that compresses a digital image. The language used in claim 16 is "to at least one of transform and convert the digital image" (claim 16, line 4). The alleged indefiniteness of this language as discussed in paragraph 10 of the April 22, 2004 Office Action will be addressed below. However, it should be noted that many different transformations and conversions of digital images are known in the prior art, in addition to

compression. Anyone who is familiar with the capabilities of programs such as Adobe® Photoshop® is well aware that digital images can be manipulated in many ways that qualify as transformation or conversion and any of these would be encompassed by the limitation on line 4 of claim 16. Some of the parameters used for transformation or conversion are even known to users of these programs. It is submitted that one of ordinary skill in the art of producing programs that manipulate digital images is well aware of the parameters and therefore, it is unnecessary to provide a list of parameters in a patent specification.

On the first four lines of paragraph 8 on page 3 of the April 22, 2004 Office Action, the Examiner referred to a lack of description of **"what is being compressed"** (Office Action, page 3, line 12). As discussed above, both claim 16 and the specification, e.g., paragraph 3, line 1 refer to "a digital image". Specifically, paragraph 18 states that "the object can be a digital image." It is submitted that one of ordinary skill in the art who had read **all** of the specification, would have no difficulty understanding that the "object" discussed in paragraph 27 may be a digital image and, as noted above, it is well known to compress digital images.

For the above reasons, withdrawal of the rejection under the first paragraph of 35 U.S.C. § 112 is respectfully requested. If the remarks above are insufficient to overcome all rejections under the first paragraph of 35 U.S.C. § 112, the Examiner is respectfully requested to contact the undersigned by telephone to arrange an Examiner Interview **prior to issuing another Office Action** to avoid a prolonged examination process by raising and requiring response in writing to issues related the Examiner's understanding of the specification.

Rejection of Claim 16 under 35 U.S.C. § 112, Second Paragraph

In paragraph 10 on page 3 of the Office Action, claim 16 was rejected under the second paragraph of 35 U.S.C. § 112 for indefiniteness with respect to the phrases "... to at least one of transform and convert the digital image ..." (claim 16, including line 4) and "determining an index by reference ..." (claim 16, starting at line 6.). With respect to the first of these limitations, as noted in the April 22, 2004 Office Action, transformation and conversion are different processes. The phrase, "to at least one of transform and convert the digital image", uses the language preferred by the Court of Appeals for the Federal Circuit for an inclusive alternative expression. See, e.g., *SuperGuide Corp. v. DirecTV Enterprises Inc.*, 69 USPQ 2d. 1865, 1876-1877 (Fed. Cir. 2004) and cases cited therein. It is submitted that there is nothing indefinite in this phrase.

The phrase "determining an index by reference to the at least one parameter" was discussed above with respect to support in the specification. It is submitted that one of ordinary

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skill in the art who has read **all** of the specification would have no difficulty understanding this limitation. If the description of the support in the specification provided above is not sufficient to withdraw the rejection under the second paragraph of 35 U.S.C. § 112, the Examiner is respectfully requested to contact the undersigned by telephone to arrange an Examiner Interview for the purpose of discussing what will be required to overcome this rejection.

Claim Rejections under 35 U.S.C. § 103

In item 12 on pages 4-6 of the Office Action, claims 16-29 were rejected under 35 U.S.C. § 103 as unpatentable over Nguyen et al. in view of Miyatake et al. In subparagraph (a) on page 4 of the Office Action, it was acknowledged that "Nguyen et al. **does not disclose** determining an index by reference to ... at least one parameter" (Office Action, page 4, lines 17-19, emphasis in original), but it was asserted that the Abstract and Summary of Miyatake et al. "**discloses** ... a graphic data management system [which] carries out ... [a] search referring to, among other tables, [an] index table which includes a pointer which ... addresses ... graphic data in the memory" (Office Action, page 4, lines 19-22, emphasis in original) . Based on these two teachings, it was asserted that "determining an index by reference to the at least one parameter" (claim 16, line 6) of a "predefined process having at least one parameter which determines a mapping of the mapping object" (claim 16, lines 4-5) is obvious "**because** indexing mechanism conserve (sic) memory space" (Office Action, page 4, last line, emphasis in original), using language that is unchanged from the November 4, 2003 Office Action.

In the Amendment filed February 3, 2004, Applicants indicated a lack of understanding of "what in Miyatake et al. corresponds to a 'predefined process having at least one parameter' (claim 16, lines 4-5) ... [and] how an index could be considered to be a predefined process" (February 3, 2004 Amendment, page 7, lines 25-27). Therefore, Applicants requested that the basis for combining Nguyen et al. and Miyatake et al. be discussed at an Examiner Interview prior to issuing another Office Action. However, no Examiner Interview was held. Instead, the Response to Amendment on page 2 of the April 22, 2004 Office Action contained only the statement that with respect to "a 'predefined process ...' (claim 16, lines 4-5) ... Nguyen covered the limitation as recited (col. 15, lines 57-67, Nguyen)." This statement does not address the issue raised in the February 3, 2004 Amendment. The issue is not what reference teaches the "predefined process," but rather how Nguyen et al. and Miyatake et al. are being combined to suggest to one of ordinary skill in the art that at least one parameter is used **both** to determine a mapping of a mapping object for a predefined process that transforms or converts a digital image (claim 16, lines 3-5) and to determine an index (claim 16, line 6).

Examiner Interview before Next Office Action

As noted in the Amendment filed February 3, 2004, during the telephonic Examiner Interview on February 2, 2004, it was agreed to conduct another Examiner Interview prior to issuing a second Office Action. However, the undersigned has no record of receiving a call from the Examiner, nor is there any mention in the April 22, 2004 Office Action of an inability of the Examiner to reach the undersigned.

The failure of the April 22, 2004 Office Action to clarify the prior art rejection, as requested in the February 3, 2004 Amendment, reinforces the need for an Examiner Interview to provide an explanation of how the prior art is being applied. Furthermore, the objections and rejections regarding the language of the specification and claims in the April 22, 2004 Office Action could have been addressed much more efficiently in an Examiner Interview than by issuing another Office Action and requiring the explanation provided above. Therefore, **the Examiner is respectfully requested to contact the undersigned by telephone to arrange an Examiner Interview prior to issuing another Office Action**, particularly if any questions remain regarding whether the claims meet the requirements of 35 U.S.C. § 112.

Summary

It is submitted that the references cited by the Examiner do not teach or suggest the features of the present claimed invention. Thus, it is submitted that claims 16-29 are in a condition suitable for allowance. Reconsideration of the claims and an early Notice of Allowance are earnestly solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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